

REMARKS

Applicant respectfully requests reconsideration in view of the foregoing amendments and the remarks hereinbelow.

The Examiner's objection to the Drawing has been noted, and the missing reference numeral "26" has been added to FIG. 8. No new matter is added.

The paragraph beginning on page 2, line 20 has been replaced to correct spelling errors in the original.

The paragraph beginning on page 3, line 1 has been replaced to correct a spelling error in the original.

The paragraph beginning on page 6, line 27 has been replaced to change a figure number as directed by the Examiner in his objection to the Specification.

The paragraph beginning on page 15, line 10 has been replaced to close a parenthetical phrase and to delete two repeated words.

The rejection of Claims 15-33 under 35-USC-112, first paragraph, has been noted. Applicant's attorney has carefully reviewed the disclosure and has amended Figs. 3-5 by placing reference numerals in correct correlation to the description set forth in the original specification. In so doing, there is now a clear description of the invention that is more than sufficient to enable one of ordinary skill in the art to practice the invention. Applicant's attorney regrets the confusion caused by the reference numerals as filed, and submits that no new material has been added.

Claim 15 stands rejected under 35-USC-102 as fully anticipated by Urban et al. The rejection is respectfully traversed. Before distinguishing Urban et al., a brief description of the present invention, as it relates to Urban et al., will be presented.

First, applicant's attorney refers to the specification to explain nest axis 42 of the drawings. Side support 46 and end support 48 define intersecting planes 56 and 58, respectively. Each plane 56 and 58 is inclined relative to the nest axis 42, which intersects the line of intersection of the two planes. The supports 46 and 48 define a transverse axis 60 (indicated by a circle in Figure 6) which follows the line of intersection of planes 56 and 58 and is perpendicular to nest axis 42.

The Examiner's attention is now directed to ram 14. According to the specification at col. 6, lines 34+, "ram 14 is movable reciprocally between a close position near the V-block 38 of the nest 12 and a far position farther removed from the V-block 38. In the embodiments shown in the figures, the ram 14 moves linearly along a ram axis 80 that extends through the center of the ram 14. The ram axis 80 is parallel to or coextensive with the nest axis 42." (emphasis added)

Referring to Claim 15, we find that it does not require that the ram move along the nest axis (as does Claim 16), but it does require that the ram be aligned with the nest axis in the near position.

Compare this to Urban et al., wherein a properly defined nest axis would extend vertically from the intersection of the two walls at the bottom of opening 3. Examination of Urban et al. clearly shows that its "ram" (which is lid 11) is not aligned with the nest axis in the near positions. In fact, Urban et al. states that lid 11 exerts a force F on tablet 10 "proximate the outer edge 10" of the portion of tablet 10 extending beyond the top surface 2 (emphasis added)." See col. 2, lines 53-57. Thus, one sees that Urban et al. does not anticipate this particular claimed feature of the present invention.

Nor would it have been obvious to modify Urban et al. so that lid 11 is aligned with the nest axis in the near position. If that were done, lid 11's force would be inside of edge 9 and the tablet would not break as intended, but would crumble. Thus, the function of Urban et al. would be changed or destroyed.

While the distinction discussed above would be sufficient for patentability, there is yet another claimed feature of the present invention that is not found in Urban et al. In the illustrated embodiments of the present application, side support plane 56 and end support plane 58 are each inclined at a different angle relative to the nest axis 42. Referring to the text of the Specification, "side support 46 is disposed at an angle of about 30 degrees (30 ± 1 degrees) to the nest axis 42 and the end support 48 is disposed at an angle of about 60 degrees (60 ± 1) to the nest axis 42". While the planes 56 and 58 can both be inclined at the same angle relative to the nest axis 42, the described different angles are indicated in the specification as optimal for a broader range of

shapes of derelict products 16. Claim 15 clearly calls for this feature, setting forth that the “supports being inclined at different angles to said nest axis”.

In every embodiment of Urban et al. which includes lid 11, a properly defined nest axis would extend perpendicular to the bottom of base 4 (the present application states that “datum structure 40 is the flat bottom of the V-block 38 and the nest axis 42 is perpendicular to the flat bottom”; col. 4, lines 6-8). As such, the hypothetical nest angle would bisect the angle formed between the two walls at the bottom of opening 3. Accordingly, we find another distinction between the claimed invention of Claim 15 and Urban et al.

Claim 16 also stands rejected under 35-USC-102 as fully anticipated by Urban et al. The rejection is respectfully traversed. Not only is Claim 16 allowable for the reasons set forth above with respect to Claim 15, but Claim 16 also requires that the ram move “along said nest axis”. Since, as explained above, Urban et al. clearly shows that its “ram” (which is lid 11) is not aligned with the nest axis in the near positions, it clearly does not move along the nest axis.

Claims 17-19 and 31 stand rejected under 35-USC-103 as being unpatentable over Urban et al. in view of Kim et al. The rejection is respectfully traversed for the following reasons.

The references in combination do not disclose the claimed invention. As discussed above with reference to the rejection of Claim 15, the primary reference (Urban et al.) fails to disclose the features of Claim 15, and the secondary reference (Kim et al.) fails to disclose, in conceptual terms, the information undisclosed by the primary reference. Therefore, Assuming *arguendo* that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. “Each element of a claim is material.” *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985)

Over and above the fact that the combination of Urban et al. and Kim et al. fails to disclose the features of Claims 17-19 and 31; the combination suggested by the Examiner (using the air sweep of Kim et al. to clear the nest of Urban et al. would have been unobvious to a person skilled in the art. The device of Urban et al. is intended as a substitute for manually splitting pills into separate

dosages. Its intent is to provide two or more pieces to be administered at different times. One would not find it obvious to provide such a device with an air sweep, as this would render an extreme risk of blowing away at least part of the pill. Although the prior art may be readily modifiable in "the manner suggested by the Examiner", this does not "make the modification obvious" and there is no motivation to one skilled in the art to modify the subject matter of the primary reference in light of the teachings of the secondary reference, unless the prior art suggested the desirability of the modification. Further, "it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ2d 1780 (CAFC 1992) The mere fact that a reference could be modified does not make "the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. See *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ 2d 1529, (Fed. Cir., 1988) Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 20 USPQ 1438, 1442 (Fed. Cir., 1991) In the present case, one would expect failure if an air sweep were added to a pill splitter.

Claims 27 and 28 stand rejected under 35-USC-103 as being unpatentable over Urvan et al. in view of Kim et al. The rejection is respectfully traversed for the following reasons.

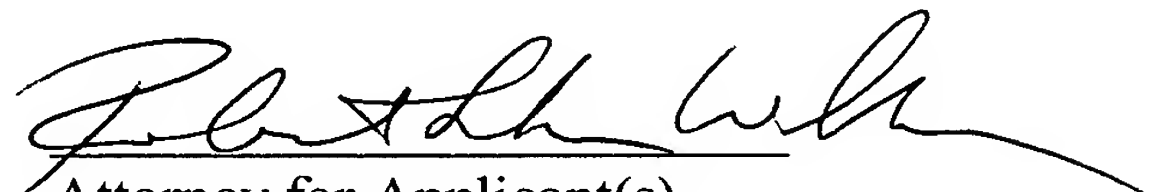
First, Urvan et al. fails to disclose the features of a ram having an axis at which the planes of the first and second supports meet, and the secondary reference (Kim et al.) fails to disclose the information undisclosed by the primary reference. Therefore, Assuming *arguendo* that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination.

Second, the combination suggested by the Examiner (using the air sweep of Kim et al. to clear the nest of Urvan et al. would have been unobvious to a person skilled in the art for the reasons set forth in the argument above with respect to the rejection of Claims 17-19 and 31.

Claims 20, 26, 32 and 33 have not been rejected over prior art.

It is respectfully submitted, therefore, that in view of the above amendments and remarks, that this application is now in condition for allowance, prompt notice of which is earnestly solicited.

Respectfully submitted,


Attorney for Applicant(s)
Registration No. 30,700

Robert Luke Walker/amb
Rochester, NY 14650
Telephone: (585) 588-2739
Facsimile: (585) 477-1148

Enclosures: Replacement Sheets 3-5 and 8.
Annotated Sheets Showing Changes.
Letter to the Draftsperson
Copies of Formal Drawings



Appl. No. 10/662,267
Amdt. Dated August 5, 2004
Reply to Office Action
Annotated Sheet

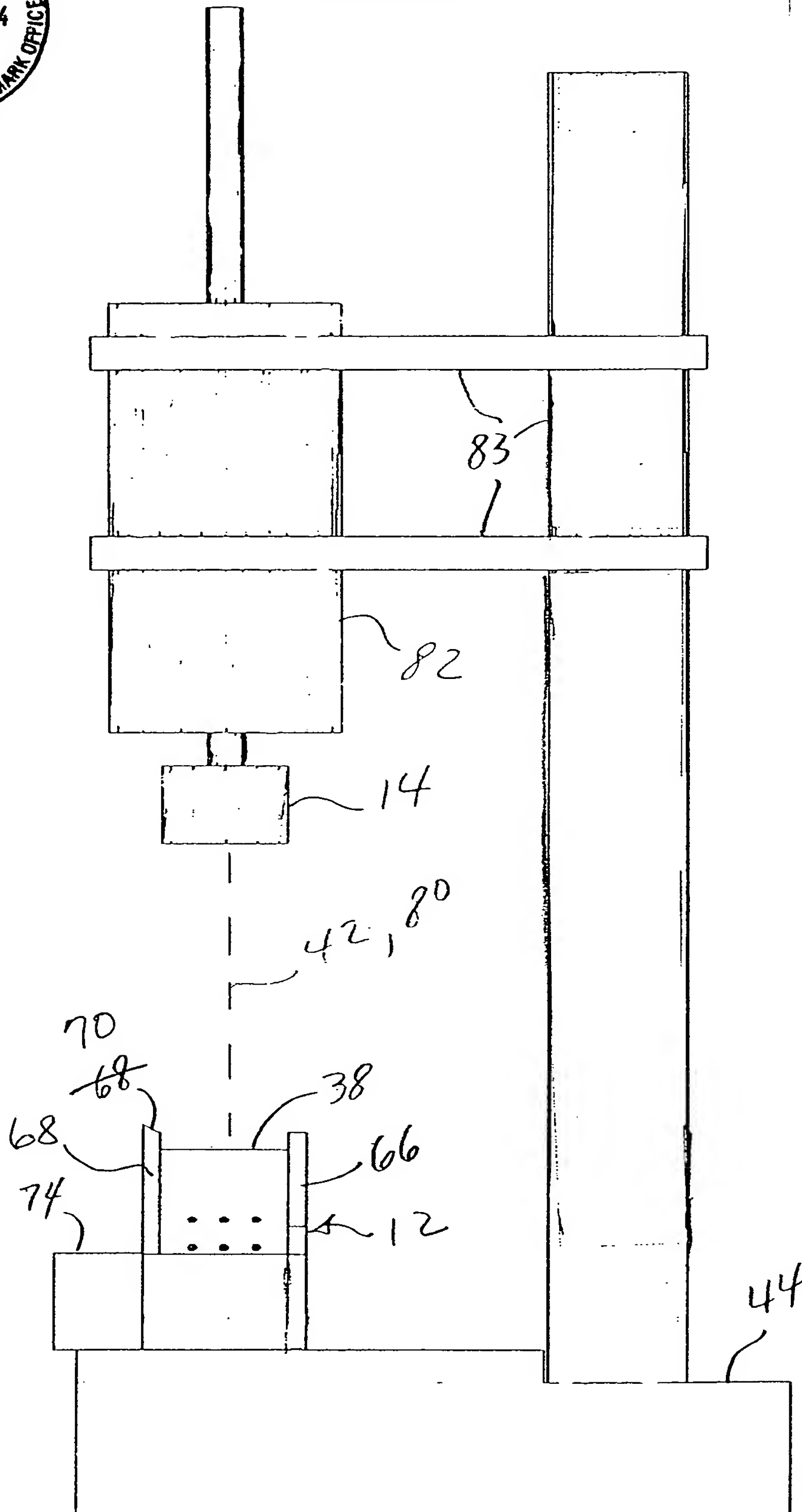


Fig. 3

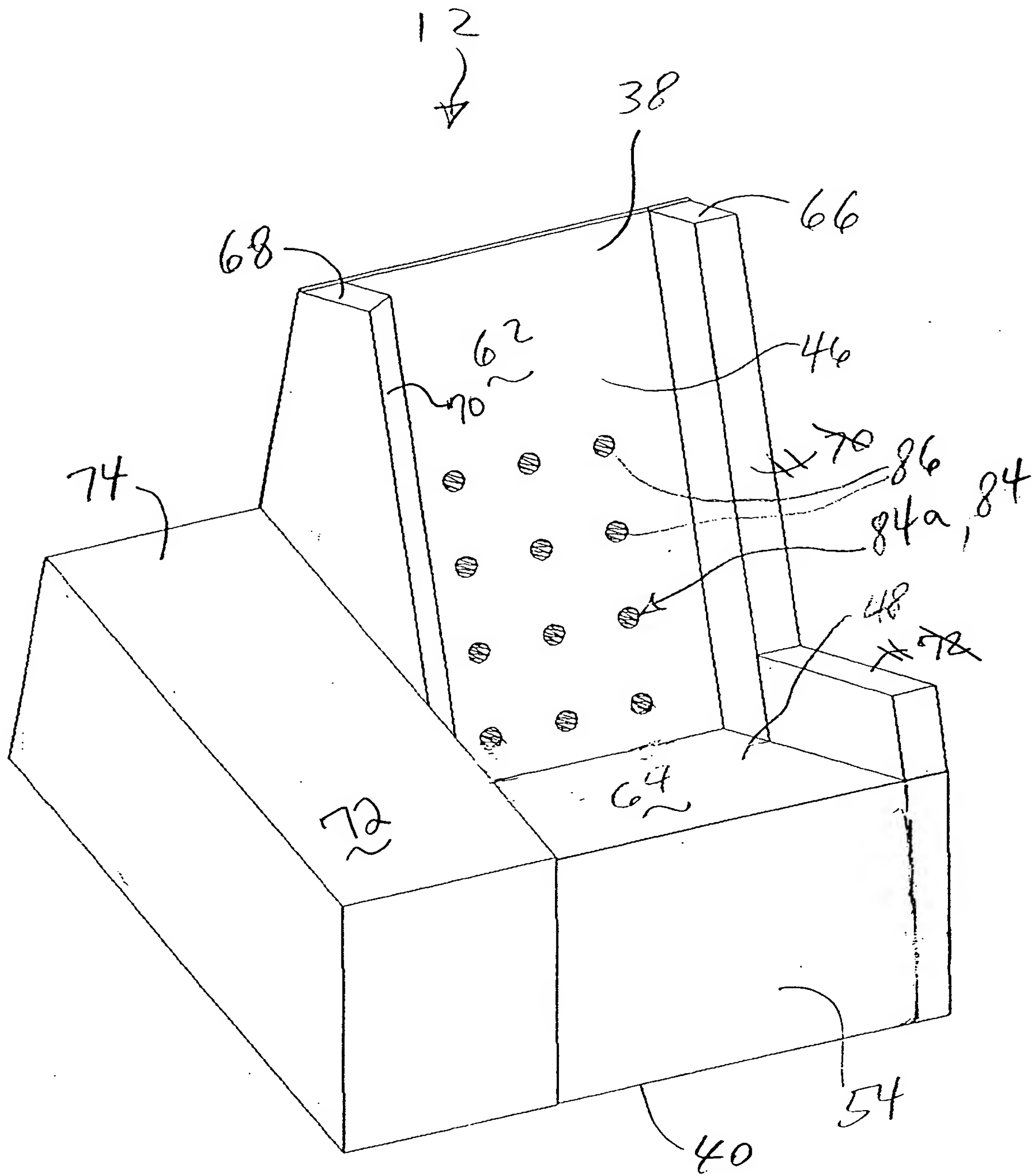


Fig. 5

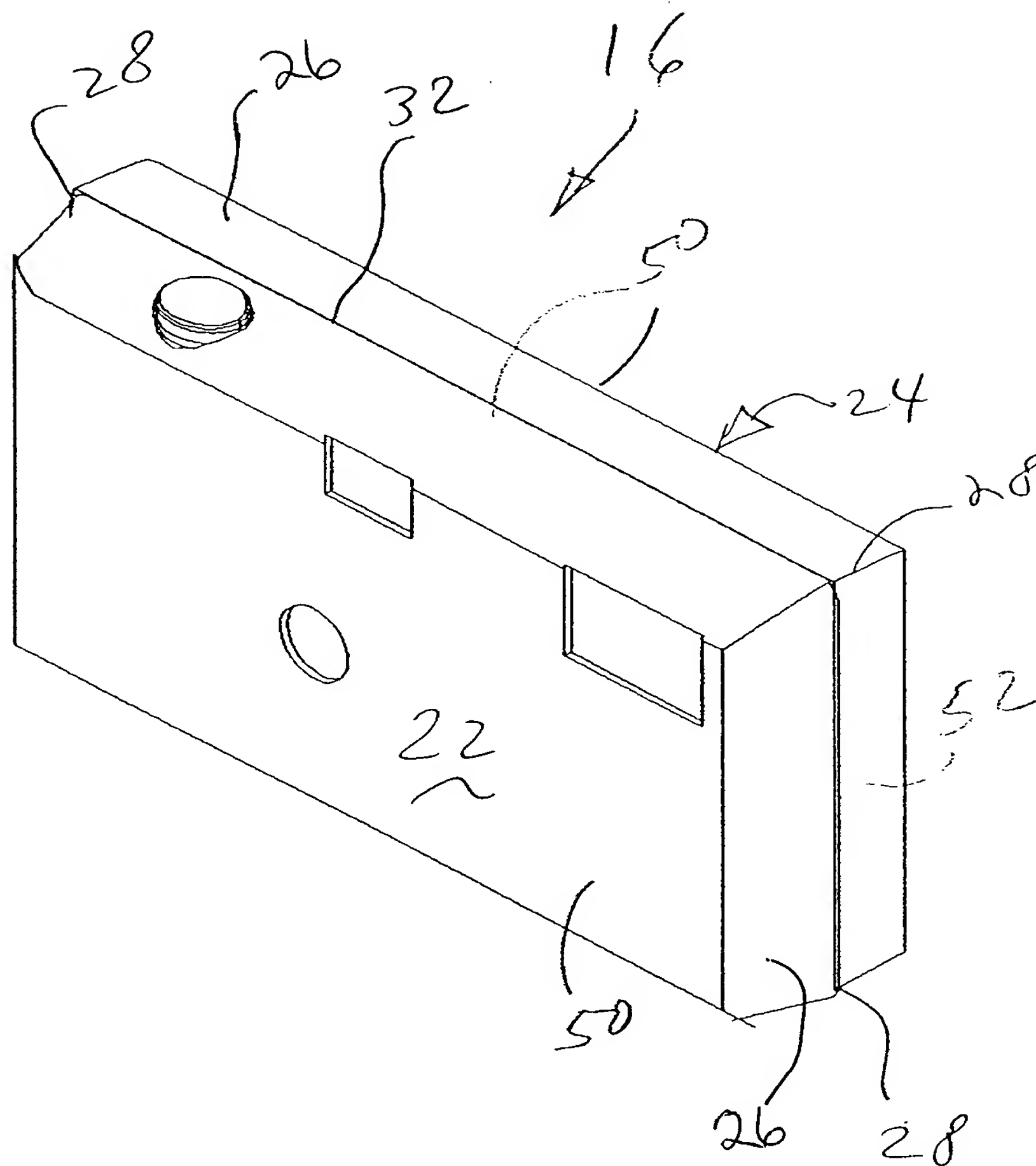


Fig. 8